

### REMARKS

At the outset, Applicants wish to bring to the Examiner's attention the newly executed Revocation and Power of Attorney which accompanies this communication. Communication with the Attorneys of Record would be appreciated.

The Office Action dated January 24, 2005 has been received and carefully noted. The following remarks are submitted as a full and complete response thereto. Claims 1-47 remain pending in the instant application and are again submitted for consideration.

The Office Action objected to the drawings, specifically objecting to Figs. 5 & 6 "because the portion 42 is unreadable." Applicants note that the Office Action Summary indicates that the drawings filed 7/17/2000, were objected to. Applicants note, however, that formal drawings were submitted on May 16, 2001. The latter filing has not been acknowledged and, based on the objection, it is believed that the formal drawings overcome the objection to figures 5 and 6. Applicants respectfully submit a courtesy copy of the formal drawings and respectfully request that the Examiner reconsider the objection in view of the formal drawings.

Claims 1-47 are pending in the above-cited application and have again been examined. The Office Action rejected claims 1-47 under 35 U.S.C. §103(a) as being unpatentable over *Ludwig et al.* (U.S. Patent No. 6,697,352) in view of *Schuster et al.* (U.S. Patent No. 6,625,119). The Office Action took the position that *Ludwig et al.* taught all of the elements of the independent claims with the exception of encapsulating, at the network element, the

second message into a third message. The rejection alleged that *Schuster et al.* teaches this latter element and that the combination of the two references rendered obvious claims 1-47. Applicants respectfully traverse the rejection, as discussed below.

Claim 1 recites a method for carrying call control information after a call handover from an Internet Protocol (IP) packet switched network to a circuit switched cellular network. The method includes generating a first message containing call control information, the first message being of an IP-based protocol encapsulating the first message into a second message, transferring the second message to a network element, the network element being part of a circuit switched cellular network and encapsulating, at the network element, the second message into a third message. Thereafter, the method includes transferring the third message to a gateway, extracting, at the gateway, the first message from the third message and sending the first message to a server in an IP packet switched network. The first message is carried through the circuit switched network transparently. Claims 2-12 and 22 depend from claim 1.

Claim 13 recites a method for carrying call control information after a call handover from an Internet Protocol (IP) packet switched network to a circuit switched cellular network. The method includes generating, at an IP packet switched network, a first message containing call control information, the first message being of an IP-based protocol, encapsulating, at a gateway, the first message into a second message, encapsulating, at the

gateway, the second message into a third message and transferring the third message to a network element, the network element being part of a circuit switched cellular network. Thereafter, the method includes transferring the second message to a user device, extracting, at the user device, the first message from the second message and sending the first message to an application at the user device. The first message is carried through the circuit switched network transparently. Claims 14-21, 23 and 24 depend from claim 13.

Claim 25 recites a system for carrying call control information after a call handover from an Internet Protocol (IP) packet switched network to a circuit switched cellular network. The system includes an IP packet switched network, the IP packet switched network including a processing server, the processing server capable of processing IP-based protocol messages, a network element, the network element being part of a circuit switched cellular network, a gateway, the gateway operatively connected to the IP packet switched network and the circuit switched cellular network, the gateway capable of encapsulating an IP-based protocol message into a payload of a second message, the gateway further capable of extracting an IP-based protocol message from a payload of another message, and at least one user device, capable of transmitting and receiving to/from the IP packet switched network and the circuit switched cellular network, the at least one user device capable of encapsulating an IP-based protocol message into a payload of a second message, the at least one user device further capable of extracting an IP-based protocol message from a payload of

another message. The IP-based protocol message includes call control information that is encapsulated, transparently carried through the switched cellular network, and extracted, the call control information being carried between the IP packet switched network and the at least one user device. Claims 26-32 and 35-42 depend from claim 25.

Claim 33 recites a system for carrying call control information after a call handover from an Internet Protocol (IP) packet switched network to a circuit switched cellular network. The system includes a first packet switched network, a circuit switched cellular system, the circuit switched cellular system comprising a circuit switched cellular network and a second packet switched network and at least one user device, the at least one user device operatively connected to the IP packet switched network and the circuit switched cellular system. The call control information is carried in packets between the IP packet switched network and the at least one user device transparently through the second packet switched network. Claims 34 and 43 depend from claim 33.

Claim 44 recites an article comprising a storage medium having instructions stored therein, the instructions when executed causing a computing device to perform specific steps. The steps include generating a first message containing call control information, the first message being of an IP-based protocol, encapsulating the first message into a second message, transferring the second message to a network element, the network element being part of a circuit switched cellular network, receiving a second message from a network

element, the network element being part of a circuit switched cellular network, the second message containing a first message, the first message containing call control information, the first message being of an IP-based protocol and extracting the first message from the second message. The first message is carried between a user device and a packet switched network through the circuit switched cellular network transparently.

Claim 45 recites an article comprising a storage medium having instructions stored therein, the instructions when executed causing a computing device to perform specific steps.

Thos steps include receiving a second message from a network element, the network element being part of a circuit switched cellular network, the second message containing a first message, the first message containing call control information, the first message being of an IP-based protocol, extracting the first message from the second message, sending the first message to a server in a packet switched network, receiving a first message from a packet switched network, the first message containing call control information, the first message being of an IP-based protocol, encapsulating the first message into a second message, encapsulating the second message into a third message and carrying the third message to a network element, the network element being part of a circuit switched cellular network. The first message is carried between a user device and a packet switched network through the circuit switched cellular network transparently.

Claim 46 recites a method for carrying call control information after a call handover

from a circuit switched cellular network to an Internet Protocol (IP) packet switched network.

The method includes generating a first message containing call control information, the first message being of a circuit switched protocol, encapsulating the first message into a second message, transferring the second message to a server in an IP packet switched network, transferring the second message to a gateway, extracting, at the gateway, the first message from the second message and sending the first message to a network element, the network element being part of a circuit switched cellular network. The first message is carried through the packet switched network transparently.

Claim 47 recites a method for carrying call control information after a call handover from an Internet Protocol (IP) packet switched network to a circuit switched cellular network.

The method includes generating, at a network element, a first message containing call control information, the network element being part of a circuit switched cellular network, encapsulating, at a gateway, the first message into a second message, transferring the second message to a server in an IP packet switched network, transferring the second message to a user device, extracting, at the user device, the first message from the second message and sending the first message to an application at the user device. The first message is carried through the packet switched network transparently.

As discussed in the present specification, the present invention enables the carriage of call control information after a call handover from an Internet Protocol (IP) packet switched

network to a circuit switched cellular network. It is respectfully submitted that the prior art of *Ludwig et al.* and *Schuster et al.*, when viewed alone or when combined, fails to disclose or suggest the elements of any of the presently pending claims. Therefore, the prior art fails to provide the critical and unobvious advantages discussed above.

*Ludwig et al.* is directed to a communications device and method thereof. *Ludwig et al.* discloses that a packet may be embedded using protocols that are sensitive to the type of data being embedded, so that adjustable parameters can be set automatically at the layer providing the parameters being adjusted. The rejection specifically refers to Fig. 6, where an IP host sends data through a mobile station to a base station of a GSM network. An interface between the GSM network and the ISP through the PSTN acts to allow for the further transport of the data, so that the data may reach the second IP host through the internet. Given the section of *Ludwig et al.* referred to in the rejection, the Office Action appears to take the position that the gateway of the ISP to be the gateway element recited in the independent claims.

The rejection acknowledges that *Ludwig et al.* fails to teach that the network element encapsulates the second message to form the third message. Because of this, the rejection also cites *Schuster et al.* *Schuster et al.* is directed to a method and system for facilitating increased call traffic in a public emergency mode. *Schuster et al.* discloses that a different type of coding may be employed in a gateway to encode streams at a lower rate once the

emergency mode is indicated. Applicants note that this description in *Schuster et al.* appears to be what the Office Action is relying on to teach the missing encapsulation.

Applicants respectfully traverse the rejection of claims 1-47 according to numerous grounds discussed below. First, Applicants respectfully point out that claims 1 and 46 recite, in part, “extracting, at the gateway, the first message from the third message,” claims 13 and 47 recite, in part, “extracting, at the user device, the first message from the second message.”

In addition, claim 25 recites, in part, “the gateway further capable of extracting an IP-based protocol message from a payload of another message,” and claims 44 and 45 reciting, in part, that the computing device performs the step of “extracting the first message from the second message.” The rejection refers to column 2, lines 34-38, of *Ludwig et al.* as teaching the extraction or de-encapsulation. However, *Ludwig et al.* is not specific as to where such a process occurs. Given that *Ludwig et al.* fails to teach encapsulation occurring in the hosts or gateway, it cannot be concluded that such extraction would obviously occur in those locations. Thus, Applicants respectfully argue that *Ludwig et al.* fails to teach the above-cited elements of claims 1, 13, 25 and 44-47 and that the rejection of those claims, and claims dependent thereon, is improper and should be withdrawn.

In addition, Applicants also respectfully assert that *Schuster et al.* cannot cure the acknowledged defects of *Ludwig et al.*, because *Schuster et al.* does not teach what has been alleged in the rejection. As noted above, *Schuster et al.* details the use of two different types



of coding depending on whether an emergency mode has been indicated. *Schuster et al.* does not teach or suggest encapsulating, at a network element, the second message into a third message. The process detailed in *Schuster et al.* are performed in the alternative and do not relate to an additional encapsulation step. Given that *Schuster et al.* does not teach the element of *Ludwig et al.* acknowledged to be missing, Applicants respectfully assert that the rejection is improper and should be withdrawn.

Additionally, Applicants note that several of the claims, namely claims 6-8, 18, 19, 29 and 30, were rejected and indicated that the limitations in those claims would be "design choice." Applicants respectfully traverse this finding because it is believed that the use of design choice is being misapplied in rendering elements of claims to be obvious. The finding of "obvious design choice" is precluded where the claimed structure and the function it performs are different from the prior art. See, In re Gal, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992). The Office Action has not presented that an IS-41 network or an IS-136 network, or equivalents thereof, are found in either *Ludwig et al.* or *Schuster et al.* Similarly, the Office Action has not shown that the generation and encapsulation at the user device, or some equivalent thereof, is performed in either *Ludwig et al.* or *Schuster et al.* For this additional reason, Applicants respectfully assert that the prior art rejection of claims 6-8, 18, 19, 29 and 30 is improper and should be withdrawn.

In view of the above, Applicants respectfully submit that claims 1-47 each recite

subject matter which is neither disclosed nor suggested in a combination of *Ludwig et al.* and *Schuster et al.* It is therefore respectfully requested that all of claims 1-47 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



Kevin F. Turner  
Registration No. 43,437

**Customer No. 32294**  
SQUIRE, SANDERS & DEMPSEY LLP  
14<sup>TH</sup> Floor  
8000 Towers Crescent Drive  
Tysons Corner, Virginia 22182-2700  
Telephone: 703-720-7800  
Fax: 703-720-7802

KFT:dll

Enclosures: Courtesy Copy of Drawings submitted on May 16, 2001  
Revocation and New Power of Attorney